

I. Preliminary Matters

Applicant respectfully requests that the Examiner approve the drawings filed October 14, 2003.

Further, Applicant respectfully requests that the Examiner initial the Form PTO-1449 filed on September 25, 2001 and July 7, 2003.

II. Claim Rejections under 35 U.S.C. § 102

Claims 1, 18 and 19 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Coulombier (U.S. Patent No. 6,310,533).

Claim 1 recites that said “cover member protecting said coil from said molding pressure when said cover is molded around said cover member.” The Examiner asserts that it would be inherent that the insulating tape (cover member as cited by the Examiner) protects coil 14 from molding pressure since it surrounds the coil 14.

On the contrary, the insulating tape merely holds coil 14 in place during the injection of encapsulating resin 13. Further, a bond can be formed between encapsulating resin 13 and the insulating tape. See col. 4, lines 10-14. However, there is no teaching or suggestion that the insulating tape protects the coil 14 from molding pressure. To the contrary, there is every reason to assume that the tape has no effect whatever upon the molding pressure imported to the coil. In relying upon the theory of inherency, the examiner must provide a basis in fact and or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461,

1464 (Bd. Pat. App. & Inter. 1990). The Examiner has provided no reasoning as to why the insulating tape of Coulombier would protect a coil from molding pressure other than stating that it would be inherent. In fact, Applicants believe that no such reasoning is available in this particular instance.

For at least the above reasons, claims 1, 18 and 19 and their dependent claims should be deemed allowable.

III. Rejection of claims 8 and 15 under 35 U.S.C. § 103

Claims 8 and 15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Coulombier in view of Ghorashi et al. (U.S. Patent No. 5,202,187). Claims 8 and 15 should be deemed patentable by virtue of their dependency to claim 1 for the reasons set forth above. Moreover, Ghorashi does not cure the deficiencies of Coulombier.

IV. Rejection of claims 9-11 and 16 under 35 U.S.C. § 103

Claims 9-11 and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Coulombier.

The Examiner asserts that the specific environment in which the electromagnet is used is a design choice based on the user's requirements and that it would have been obvious to one of skill in the art to use the electromagnetic device in various environments.

Claim 9 recites that the electromagnetic device is a motor, claim 10 recites that the electromagnetic device is a transmission control valve, claim 11 recites a case containing oil and

claim 16 recites a pair of copper coils. The recitation of a motor, a transmission control valve, a case containing oil, and a pair of copper coils are structural limitations and are not mere design choice. Moreover, there is no teaching or suggestion of a motor, a transmission control valve, a case containing oil or a pair of copper coils as recited in claims 9-11 and 16 in the cited art.

For at least the above reasons, claims 9-11 and 16 should be deemed allowable.

V. Rejection of claims 12 and 13 under 35 U.S.C. § 103

Claims 12 and 13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Coulombier in view of Trunzo et al.

Claim 12 recites “a conductor wound around said bobbin and coated with an outer coating ... said outer coating comprises an insulating layer which is made of enamel formed over the conductor and a welding layer which is made of thermoset epoxy formed over the insulating layer.” The Examiner asserts that the aspects of claim 12 are disclosed in Trunzo. However, there is no teaching or suggestion of a welding layer that is made of thermoset epoxy.

For at least the above reasons, claims 12 and 13 should be deemed allowable.

VI. Conclusion

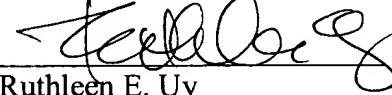
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

RESPONSE UNDER 37 C.F.R. § 1.116
Appln. No.: 09/961,273

Attorney Docket No.: Q65705

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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